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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,902	04/13/2004	R. Payson Moreland	P06107US01	3996
22885	7590	12/21/2005	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			LOCKETT, KIMBERLY R	
			ART UNIT	PAPER NUMBER
			2837	

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/822,902

Applicant(s)

MORELAND, R. PAYSON

Examiner

Kim R. Lockett

Art Unit

2837

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 is/are allowed.
- 6) ☒ Claim(s) 1-27 and 29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/13/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 6-9, 14, 27, and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Polley.

Polley discloses the use of a textured apparatus(47) for use with a stringed instrument pick that does not change the function of a pick, the apparatus having a grip portion on a first surface comprising a relatively thin piece of material having the following properties (see figure 1): resists sliding and promotes gripping by human fingers; is applicable to the gripping portion on the first surface (column 2, lines 65-68). The apparatus as disclosed by Polley also discloses the use of material that fits within the perimeter dimensions of a pick, that can be retrofitted to an existing pick, and is adapted for various sized picks and has removable adhesion to a pick by surface tension without residue.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polley in view of Jonathan.

Polley does not disclose the specific use of a flexible material.

Jonathan discloses the use of an apparatus for use with a stringed instrument pick that is a rubbery moldable apparatus(3) with a smooth surface for use with a stringed instrument pick.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device as disclosed by Polley with the rubbery material as disclosed by Jonathan in order to provide a non-slip coaction between the pick and musician's finger.

5. Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polley in view of US 2002/0108483A1.

Polley does not disclose the use of a thickness variance.

US 2002/0108483A1 discloses use of an apparatus for use with a stringed instrument pick with a raised thickness variance (page 2, column 2, lines 22-30) on the order of the pick to which it's to be applied.

Polley and US 2002/0108483A1 do not disclose the specific diameters as disclosed by the applicant. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the diameters to those as claimed by the applicant since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device as disclosed by Polley with the thickness variance as disclosed by US 2002/0108483A1 in order to provide a pick that keeps excess perspiration away from the finger tips.

6. Claims 3-5, 26, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Polley in view of Hodesh (US 2005/0217456A1).

Polley does not disclose the specific use of material that is adapted for removeably adhesion to a pick.

Hodesh (US 2005/0217456A1) discloses the use of a pick with a material that is adapted for removeably adhesion to a pick.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device as disclosed by Polley with the material as

disclosed by Hodesh (US 2005/0217456A1) in order to provide a pick with a special adhesion material.

7. Claim 28 is allowed.

Response to Arguments

8. Applicant's arguments filed 9/27/05 have been fully considered but they are not persuasive. With regards to applicant's arguments regarding the Polley reference, Polley clearly discloses the use of a relatively flat material used for a non-slip grip. In reference to the applicants disclosure of column 3, lines 9-12, Polley refers to "material on both sides" of the pick not being preferred because the material on both sides provides a thick feel. Polley clearly discloses that his material is adapted to be adhered to one side of a gripping portion of the pick (column 3, lines 13-15). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case the objective teaching is that Polley and Jonathan both disclose the use of a grip for preventing slippage. Therefore, it would have been obvious to one of ordinary skill in the art to replace the material as disclosed by Polley to include the material as disclosed by Jonathan since both prevent slippage.

9. Papers related to this application may be submitted to Group 2800 by facsimile transmission. Papers should be faxed to Group 2800 via the PTO 2800 Fax Center at 703-872-9306.

For assistance in **Patent procedure, fees or general Patent questions** calls should be directed to the **Patents Assistance Center (PAC)** whose **telephone number is 800-786-9199**. Assistance is also available on the Internet at www.uspto.gov.

Any inquiry concerning **this communication or earlier communications from the examiner** should be directed to **Kim Lockett whose telephone number is (703) 308-7615, after 2/3/04 my new number will be (571) 272-2067**. The examiner can normally be reached on Tuesday through Friday from 6:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on (571) 272-2107.


KIMBERLY LOCKETT
PRIMARY EXAMINER